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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,864	01/16/2001	Mika Partain	2271/63926	4206
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COOPER & DUNHAM, LLP 30 Rockefeller Plaza 20th Floor NEW YORK, NY 10112			EXAMINER MISIASZEK, MICHAEL	
			ART UNIT 3625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/760,864

Applicant(s)

PARTAIN ET AL.

Examiner

MICHAEL MISIASZEK

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendments filed 4/6/2009 have been received and reviewed. The status of the claims is as follows:

Claims 45-63 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 45-60, 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mesaros in view of Rubin and Postelik.

Regarding Claims 45, 52, 58, 62

Mesaros discloses a method and system for enhancing product sales in network transactions, the method comprising:

- delivering display Information to a customer side for ordering products or services via a network (at least column 7, lines 8-9 and figure 2)
- receiving at a seller side an initial order from the customer side, including said initial order comprising (i) customer side information including an identity of a client and (ii) an initial specified quantity (at least column 7, lines 8-9, 32-50 and figures 2, 5)

- changing the display information at the customer side to reflect the transaction and a promotion, if said specified quantity of said initial order is in a range equal to or higher than a first predetermined quantity but lower than a third predetermined quantity (at least figures 4, 13 and 14; where ranges of quantity are offered different prices. For example, between 101-200 is one range (where 101 is a first predetermined quantity and 200 is a second predetermined quantity))
- changing the display information at the customer side to reflect the transaction and a promotion, if said specified quantity is equal to or greater than said third predetermined quantity; (at least figures 4, 13 and 14)
- processing and executing the order with the appropriate corresponding promotion (at least column 6, line 48-column 7, line 32)

Mesaros also does not expressly disclose changing display information to be delivered to the customer said in accordance with the specified quantity of the specified product. Rubin teaches this (Rubin: column 4, lines 55-65). Rubin discloses a method wherein least expensive additional order calculator 232 divides the additional volume by the volume contribution of each product having a vendor equal to the vendor identified in the proposed order stored in proposed order storage 212. For each product, the result of this division is rounded up and the rounded result multiplied by the price of the product to produce an extended price. One or more of the minimum extended prices is selected and the corresponding product identifier, quantity and total price is provided by

least expensive additional order calculator 232 to administration 250 for presentation to the user. At the time of invention it would have been obvious to one of ordinary skill in the art to have modified the method of Mesaros to incorporate the promotion scheme of Rubin because of the complexity of some discount structures a consumer may not be aware at the time of an order that a moderately larger order can increase a discount available (Rubin: column 1, line 65 to column 2, line 17).

Mesaros further does not expressly disclose making a determination of the type of initial order based on customer side information, and treating the initial order based on the determination. Postelik teaches that it is known to determine the type of initial order, and treating the initial order based on the determination (at least paragraph [0090]) in a similar environment. It would have been obvious to have modified the system and method, as taught by Mesaros, with the determination, as taught by Postelik, since such a modification would only united elements of the prior art references, with no change in their respective functions and which yield predictable results.

Regarding Claim 46, 60

Mesaros further discloses wherein the display information indicative of a first promotion includes information regarding a difference between the initial order quantity and a quantity for qualifying for the first promotion (Mesaros: Fig. 4, "188" and "189"). Mesaros discloses wherein the first promotion includes providing without charge one or more products different from the specified product (Mesaros: figure 8). Mesaros further

discloses a method wherein the customer side and seller side are at geographical remote locations (Mesaros: Fig. 1).

Referring to claim 47, 49, and 59,

Mesaros and Rubin fail to explicitly teach "wherein if the customer side confirms the initial order without modifying the initial order, the seller side determines that the initial order does not qualify as a retail-customer-to-business transaction", "wherein if the customer side confirms the initial order without modifying the initial order, the seller side determines the transaction does not qualify as the business-to-business transaction", and "wherein said determination part determines that the initial order is a business to business transaction based on the identity of the customer". Examiner takes Official Notice that it is old and well-known in the art to have these features. It would have been obvious, at the time of the invention, to one ordinary skill in the art to modify Mesaros to include features that describe the transactions and orders based on whether the customer confirms the order without revising or based on the identity of the customer, rendering the order as not a retail-customer-to-business transaction and the transaction not as a business-to-business transaction, in order to enhance customer relationship management.

Referring to claim 48,

Mesaros teaches "wherein when the specified quantity of the initial order is greater than said first predetermined quantity but less than said third predetermined quantity, the

seller side calculates a quantity difference to qualify for the business to business transaction and promotion, and displays the quantity difference along with business-to-business transaction and promotion information at the customer side display, and provides the customer side with an option of modifying the order" (Mesaros: figures 4, 13, and 14. The feature of "modifying" is addressed by the rejections of claims 25 and 27-29; therefore the same rejections apply to this claim.).

Referring to claim 50,

Mesaros teaches "displaying at the customer side, information reflecting the revised order that conforms to the selected promotion, whereby the initial order is no longer operative at the seller side" and "executing the revised order at the seller side". Rubin, in an analogous art, teaches "displaying at the customer side, information reflecting the revised order that conforms to the selected promotion, whereby the initial order is no longer operative at the seller side" (Rubin: abstract and figures 2-3) and "executing the revised order at the seller side" (Rubin: figure 3).

Referring to claim 53,

Mesaros teaches "wherein said customer side terminal displays no promotion information and execute the initial order as entered when said quantity range is determined to be below said first predetermined quantity".(Mesaros: column 7 lines 1-31; where an order can be placed without conforming to said pricing schemes).

Referring to claim 54,

Mesaros teaches “wherein said customer side terminal displays promotion information corresponding to a retail-customer-to-business transaction contingent on increasing the specified quantity of the initial order to at least a second predetermined quantity higher than said first predetermined quantity” (Mesaros: figures 4, 13, and 14).

Referring to claim 55,

Mesaros teaches “wherein said customer side terminal displays promotion and transaction information corresponding to a retail-customer-to-business transaction when the specified quantity of the initial order is lower than said third predetermined quantity but higher than said first predetermined quantity (Mesaros: figure 4; where several pricing thresholds are disclosed).

Referring to claim 56,

Mesaros teaches “wherein said customer side terminal displays promotion and transaction information corresponding to a business-to-business transaction contingent on increasing the specified quantity of the initial order to a fourth predetermined quantity.” (Mesaros: figure 4; where several pricing thresholds are disclosed).

Referring to claim 57,

Mesaros teaches “wherein said customer side terminal displays promotion and transaction information corresponding to a business-to-business transaction when the

specified quantity of the initial order is determined to be equal to or above said third predetermined quantity but below a fourth predetermined quantity" (Mesaros: figure 4; where several pricing thresholds are disclosed).

Referring to claim 63.

Mesaros discloses wherein any one of the retail-customer-to-business promotion and business-to-business promotion is related to delivery methods for delivering ordered products (at least column 12, lines 1-14: products delivered, therefore promotion related to delivery method)

Referring to claim 64.

Mesaros discloses wherein any one of the retail-customer-to-business promotion and business-to-business promotion is related to payment terms for paying for ordered products (at least column 6, line 48-column 7, line 32: customer-vendor promotions involve price discounts)

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mesaros in view of Rubin and Postelik, as applied above, and further in view of Unold et al. (US 20020055880 A1, hereinafter Unold).

Mesaros fails to explicitly disclose wherein said retail-customer-to-business promotion is different from said business-to-business promotion. Unold teaches that it is known to include multiple different types of promotions (at least paragraph 61) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention, as taught by Mesaros, Rubin, and Postelik, with the multiple types of promotions, as taught by Unold, since such a modification would have provided the rapid creation of electronic advertisements and promotions (at least paragraph 7 of Unold).

Response to Arguments

Applicant's arguments with respect to Postelik have been fully considered, but they are not persuasive. Applicant asserts that Postelik does not teach determining whether an initial order is to be treated as a retail-customer-to-business transaction or a business-to-business transaction. Postelik, as applied above, teaches determining the type of an initial transaction, and thusly processing the transaction based on the determined transaction type. While the Examiner agrees that Postelik does not explicitly teach the specific two types of transactions (retail-customer-to-business transaction and business-to-business), the Examiner notes that the mere label of the type of transaction is considered non-functional descriptive material. Thus, the differences between the recited invention and the cited prior art are only found in the non-functional descriptive material and are not functionally involved in the steps recited. The changing the display and processing the transaction would be performed in the same manner, regardless of how transaction types are identified. Thus, this descriptive material does not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.2d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to identify the transaction types using any convention because such information does not functionally relate to the steps in the method claimed and merely labeling the transaction types differently from that in the prior art would have been obvious. See *Gulack* cited above.

Put another way, there is no functional difference between the combination of references and the claimed invention. The only difference is in the labeling of the transaction types. . Since the labeling the transaction types differently would have been obvious, as detailed above, Applicant's arguments are found to not be persuasive.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL MISIASZEK whose telephone number is (571)272-6961. The examiner can normally be reached on 9:00 AM - 5:30 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625

Michael A. Misiaszek
Patent Examiner
1/16/2010